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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,094	08/04/2003	Harold Little	HL-1-js-mv	5878

7590  
Michael I. Kroll  
171 Stillwell Lane  
Syosset, NY 11791

03/16/2005

EXAMINER

SPAHN, GAY

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/634,094

Applicant(s)

LITTLE, HAROLD

Examiner

Gay Ann Spahn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 4-11, 13, 16, 17 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 12, 14, 15, and 18 is/are rejected.
- 7) ☒ Claim(s) 2, 3, 14, and 15 is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

This application contains claims directed to the following patentably distinct species of the claimed invention: Figure 2; Figure 5; Figure 6; Figure 8; Figure 9; Figure 10; Figure 12; Figure 14; Figure 16; Figure 17; Figure 18; Figure 19; Figure 20; Figure 21; and Figure 22.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, independent claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

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case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Michael Kroll on February 18, 2005 a provisional election was made without traverse to prosecute the invention of Figure 2, claims 1-3, 12, and 18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4-11, 13- 17, and 19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 04 August 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of recesses positioned along the length of the flange of the permanent member recited in claim 2 and the hinge of the dismountable member recited in claims 14 and 15 must be shown or the features canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to because: (1) Figs. 2, 6, 9, 10, 13, 14, 17, 18, 19, 20, 21, and 22 should not be shown within a circle since the circle implies that the views are cross-sectional views from the house shown in Fig. 1 as are the cross-sectional views of Figs. 3, 7, 11, and 15; (2) Figs. 4, 5, 8, 12, and 16 are cross-sectional views, but there is no showing in any of the drawing figures from where these cross-sections are derived; and (3) while suitable descriptive legends may be used subject to approval by the Office according to 37 CFR 1.84(o), those legends that are used should contain as few words as possible and therefore, the legend "MOUNTING APPARATUS FOR GUTTERS" in Fig. 2 appears to be unnecessary since reference numeral "19" represents a gutter mounting, the legend "DRIP EDGING" in Figs. 6, 9, 18, 19, 20, 21, and 22 appears to be unnecessary since reference numeral 17 represents the drip

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edging, and the lengthy legends in Figs. 10, 11, 13, 14, 15, and 17 would appear to be better stated in either the Brief Description of the Drawing Figures section or the Detailed Description of the Preferred Embodiment section. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The

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abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the instant application, the Abstract contains legal phraseology (i.e., the word "means" in lines 3 and 5).

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 14 and 15 recite that the dismountable member includes at least one hinge or a plurality of hinges, respectively. However, the hinge structure has not been adequately described in the specification. For instance, with respect to the elected species shown in Figure 2, the specification states on page 37, lines 12-16 that "The dismountable member (26) can be of varying lengths and can incorporate elements that would allow for folding of the dismountable member (26) into predetermined lengths suitable for storage with or without the decorative lights attached thereto." It is presumed that "elements that would allow for folding of the dismountable member" is a hinge. However, without more specific disclosure, it is not understood how the dismountable member could have a hinge on it, nor how the hinge could make the dismountable member foldable.

The disclosure is objected to because of the following informalities: on page 5, line 6, there is no close parentheses (i.e., ")") for the parentheses before the word "November"; on page 6, line 5, the patent to Kelley et al. was a Canadian Patent, not a

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United States Patent; on page 49, line 7, at the end of the sentence, the "(26)s" appears to be a typographical error.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The at least one hinge in claim 14 and the plurality of hinges in claim 15 have not been adequately described in the specification. As stated above with respect to the objection to the specification, the descriptions in the specification with respect to the varies species that the dismountable member can be of varying lengths and can incorporate elements that would allow for folding of the dismountable member into predetermined lengths suitable for storage with or without the decorative lights attached thereto is not specific enough to the peculiarities, structure, placement, and workings of the hinge. Therefore, without more specific disclosure, it is not understood how the dismountable member could have a hinge on it, nor how the hinge could make the dismountable member foldable.

The following is a quotation of the second paragraph of 35 U.S.C. 112:



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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14 and 15 are vague and indefinite for failing to particularly point out and distinctly claim the peculiarities of the at least one hinge and the plurality of hinges, respectively.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 12, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Blanton.

As to claim 1, Blanton discloses a drip edging and gutter mounting (see Fig. 14) comprising:

a) a permanent member (40) mounted to a structure (the house (not shown) to which the gutter (G) is attached);

b) a dismountable member (22, Figs. 7 and 8) selectively connected to said permanent member (40); and

c) means for connecting (24) ornamental structures (A) to said dismountable member (30), wherein upon receipt of ornamental structures (A) by said connecting means (24), said dismountable member (22) is selectively connected to said permanent member (40) to thereby decorate the structure.

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As to claim 18, Blanton discloses a method for mounting ornamental structures (A) comprising the steps of:

- a) securing a permanent member (40) to a structure (house, not shown), the permanent member (40) having a rod (44) extending along a length thereof;
- b) selectively connecting ornamental structures (A) to a dismountable member (22), the dismountable member (22) is a tube including a channel having a diameter and length corresponding with a diameter and length of the rod (44) of the permanent member (40);
- (c) aligning the dismountable member (22) with the permanent member (40); and
- d) inserting the rod (44) within the channel of the tube thereby mounting the ornamental structures (A) to the structure (house, not shown).

As to claim 12, Blanton discloses that the means for connecting (24) ornamental structures comprises a plurality of hooks (24A, 24B) for receiving said ornamental structures (A) extending from and linearly along a length of said dismountable member (22).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blanton in view of Meadows, Jr.

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Blanton discloses the drip edging and gutter mounting as described above. In addition, Blanton also discloses that the permanent member (40) comprises:

- a) a U-shape connector (upper part of 41, 43 and upper part of 42);
- b) a flange (bottom part of 41) extending from and perpendicular to a first end (the plate 43 being the first end of the connector) of said U-shaped connector (upper part of 41, 43 and upper part of 42);
- c) a rod (44) extending along a length of said U-shaped connector (upper part of 41, 43 and upper part of 42) on an end opposite said flange; and
- d) wherein when said connector (upper part of 41, 43 and upper part of 42) is positioned over and around a gutter (G) of a structure (house, not shown) such that said flange (bottom part of 41) is positioned within the gutter (G) and said rod (44) is positioned adjacent the gutter (G).

Blanton fails to shown that the flange has a plurality of recesses positioned along a length thereof or a fastener received by the recess of the flange for securing the permanent member to the gutter.

Meadows, Jr. discloses a decoration device for a gutter (14), wherein a flange of the fastening strap (80) has a recess therein through which a fastener (46) is placed to connect the decoration device to the gutter (14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the fasteners and recess connection taught by Meadows, Jr. in order to more securely connect the permanent member of Blanton to the gutter.

As to claim 3, Blanton discloses that the dismountable member (22) is a tube having a channel extending along the length thereof, said channel having a shape and diameter corresponding to a shape and diameter of said rod (44), and said means for connecting (24) ornamental structures (A) is positioned along a circumference of said tube, wherein, upon aligning said tube with said U-shaped connector (upper part of 41, 43 and upper part of 42) of said permanent member (40), said rod (44) is received within said channel thereby mounting the ornamental structures (A) to the structure (house, not shown).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,652,112 to Lucarelli discloses a decorative light strip for self-attaching to a rain gutter or a roof overhang. U.S. Patent Application Publication No. 2003/0198054 to Adams discloses an apparatus for hanging rope lights from a gutter. U.S. Patent Application Publication No. 2002/0186562 to Schroetter discloses a decorative light mounting apparatus. U.S. Patent Application Publication No. 2002/0000504 to Bayne discloses a Christmas lights holder. U.S. Patent No. 6,076,938 to Kinderman discloses a hinged hanging simulated icicle frame. U.S. Patent No. 5,669,709 to Adams discloses a decorative light holder. U.S. Patent No. 5,609,415 to Protz, Jr. discloses a light clip for shingles or gutters. U.S. Patent No. 5,496,005 to Dieringer discloses a hanger for electrical conduits. U.S. Patent No. 5,056,747 to Kireta discloses a biasable bracket device for mounting a decorative light in multiple locations. U.S. Patent No. 3,599,916 to Szabo discloses a gutter clip for light strings and the like.

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U.S. Patent No. 3,584,795 to Baird discloses a flexible hanger for electric lamp sockets.

U.S. Patent No. 3,438,604 to Spicer discloses retainer clips for temporary wiring.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (703)-605-1203. The examiner can normally be reached on Monday through Thursday 8:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (703)-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

<sup>GAS</sup>  
Gay Ann Spahn, Patent Examiner  
February 28, 2005

  
**BRIAN E. GLESSNER**  
**PRIMARY EXAMINER**